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AP 1714

PATENT
Attorney Docket YO998-086
IBM-178

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Angelopoulos, et al.
Serial Number	:	09/036,458
Filing Date	:	March 6, 1998
Examiner	:	T. Yoon
Group Art Unit	:	1714
For	:	METHODS OF PROCESSING AND SYNTHESIZING ELECTRICALLY CONDUCTIVE POLYMERS AND PRECURSORS THEREOF TO FORM ELECTRICALLY CONDUCTIVE POLYMERS HAVING HIGH ELECTRICAL CONDUCTIVITY

To: The Honorable Commissioner of
Patents and Trademarks
Post Office Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Official Action dated December 30, 2003, please amend the claims in this application as set forth in Appendix A attached hereto.

In the *Decision on Appeal under 35 U.S.C. § 134* dated September 26, 2003, ("the Decision") the Honorable Board of Patent Appeals and Interferences remanded the instant application to the Examiner with the opportunity for Applicants to amend the subject matter of Claim 12 to comply with 35 U.S.C. §112, second paragraph. On November 18, 2003, Applicants elected to submit an appropriate amendment of Claim 1 as provided in the "*Appropriate Action*" section of the Decision.

Original Claim 1 in this case read:

> *A method comprising:*
> *processing a polymer selected from the group consisting of a precursor to an electrically conductive polymer and an electrically conductive polymer in a solvent comprising a fluorinate solvent, said polymer in said solvent characterized by a dependence of the electrical conductivity of said electrical conductive polymer on the concentration of said polymer in said solvent, said concentration being selected to substantially maximize said electrical conductivity.*

In the Decision the Board held that Claim12 was defective in that there is no indication of how the precursor to an electrically conductive polymer or electrically conductive polymer in a solvent is treated, manipulated or formed. In addition, the Board held in the Decision that the claim does not indicate the results which are to be achieved by the claimed method.

In the present amendment, as in the amendment submitted November 18, 2003, Applicants submit an amended version of Claim 1 for consideration by the Examiner as well as modified versions of Claim 1 found in Claims 22 - 24. The versions of the claims as contained in this amendment clearly state how the precursor to an electrically conductive polymer or electrically conductive polymer in a solvent is treated. The precursor is doped and the claims define the result (processing to form an article; basis: Page 20, line 11) which are achieved by the claimed method.

The Examiner has refused to consider Claims 23 and 24 indicating in the Official Action that "they are not official claims." Applicants respectfully submit that, as a matter of substance, these claims were properly introduced into the application in the amendment filed November 18, 2003, and should have been examined. The Examiner's refusal to enter and consider these claims was improper. Applicants acknowledge that in the aforementioned amendment, Applicants inadvertently designated Claims 23 and 24 as being "Proposed." Pursuant to 37 C.F.R. 1.121 II A)5 Applicants' proper designation should have been "New." But despite the incorrect designation, (which is solely a matter of form and is a purely semantic objection) it is clear that those claims were understood to be "New" and should have been examined. The correct parenthetical expression of claim status has now been added to these claims by inserting the word "New" before the preamble to identify the status of these claims.

The basis for the addition of the elements of "aggregation/deaggregation" and "solvation" are found in the specification.

The Examiner has rejected Claim 22 asserting that it contains "new matter." Specifically, the Examiner objects to the use of the expression "selecting said concentration to provide a selected value of said electrical conductivity" saying the limitation has no support in the specification, and applicants failed to provide any support for it.

It is clear from a reading of the specification, that in the system claimed, there is a functional relationship between the concentration of polymer in solution and electrical conductivity. Applicants' claims recite that the concentration of the polymer used in accordance with the system, will be that concentration of polymer in solution which provides the maximum conductivity. The support for this limitation is found in the specification at page 20, lines 18 - 21, which states: "*It was noticed that the conductivity (is) dependent on the concentration of the polymer in solution. From a 0.5 to 2% solution, a conductivity of 100S/cm was attained and above 3% a conductivity of 200 S/cm was attained.*" The benefits of the invention and the functional relationship between concentration and conductivity is depicted in Figures 3 - 5 of the drawings.

In view of the changes to the claims and the remarks herein, withdrawal of the rejection of Claim 22 as anticipated under 35 U.S.C. 102(b) or, in the alternative under 35 U.S.C. 103(a) as obvious over Jonas, et al.

Any fees which result from the claims added herein should be charged to Deposit Account 50-0510.

The Commissioner is requested to grant a one month extension of time within which to respond. A check in the amount of $110.00 is enclosed to cover the extension fee.

In view of the arguments and modification to the claims, allowance of Claims 1 - 24 in this case is warranted. Such favorable action is respectfully solicited.

Respectfully Submitted,

Thomas A. Beck
Registration No. 20,816
26 Rockledge Lane
New Milford, CT 06776
Telephone (860) 354-0892

I certify that this amendment is being deposited wit the United States Postal Service on the date shown below addressed to Assistant Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Thomas A. Beck April 2, 2004